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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/193,787	11/17/1998	JAY PAUL DRUMMOND	D1077+1	2446
28995	7590	02/16/2006		EXAMINER
RALPH E. JOCKE walker & jockey LPA 231 SOUTH BROADWAY MEDINA, OH 44256				WORLOH, JALATEE
			ART UNIT	PAPER NUMBER
				3621

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/193,787	DRUMMOND ET AL.
	Examiner	Art Unit
	Jalatee Worjoh	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 November 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant argues, "Claim 12 does not use "means" or "means for". Claim 12 does not invoke 35 USC 112, sixth paragraph. Thus, claim 12 cannot be "single means", as the Office alleges. However, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language. The CAFC stated in *Fiers* at 1606 "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived". See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single *means* claims even though "means" was not literally used.

2. Claims 1-30 have been examined.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because this is a "single means claim". "A means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those known to the inventor")

(see MPEP 2164.08(a). Further, there are not distinct functions that make the device of claim 12 an ATM.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/980209.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/980209 discloses an automated banking machine (automated transaction machine) including an output device, an input device, a transaction function device, a computer, wherein the transaction function responsive to the browser processing at least one document (a document) including at least one instruction (an instruction) adapted to cause the computer to cause operation of the transaction device (to operate the transaction function device).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 09/233,249.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application no. 09/233,249 discloses an automated banking machine (a first transaction machine), a computer, wherein the computer is in operative connection with the output device, the input device and the transaction function device wherein the output device outputs information, whereby a user is enabled to perceive outputs from the output device, an input device, wherein the input device is operative to receive inputs, whereby a user is enabled to provide inputs to the machine (a first computer of a first type, wherein the first computer includes at least one first output device, wherein the first output device is operative to provide at least one output to users of the first machine, and at least one first input device, wherein the first input device is operative to receive at least one input from users of the machine), a transaction function device, where the transaction function device is selectively operative to carry out a transaction (a first transaction function device in operative connection with the first computer, wherein the first transaction device is operative to carry out a transaction function), software executable in the computer, wherein the software includes a browser (first transaction machine interface software in operative connection with the first computer), the browser is operative to process HTML documents including instructions therein (a first instruction document in operative connection with the first computer, wherein the first instruction document includes at least one command instruction), wherein the transaction function device is operative to carry out

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the transaction function responsive to the browser processing at least one document including at least one instruction adapted to cause the computer to cause operation of the transaction function device (wherein the first computer is operative responsive to at least one first input to the first input device to cause the first transaction function device to carry out the transaction function and wherein the first computer is further operative to generate a first output through the first output device responsive to the first input, the first transaction machine interface software and at least one command instruction in the first instruction document.).

8. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Independent claims 8, 9, 11, 13 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting are all rejected as non-statutory obviousness type double patenting as being unpatentable over claim 1 of copending Application No. 10/980209 and 09/233,249. Note. These claims are rejected on the same rationale as independent claim 1 above.

10. Claims 2-7, 10, 12, 14, and 17-30 are rejected as being dependant upon independent claims 1,8,9,11,13 and 16 above.

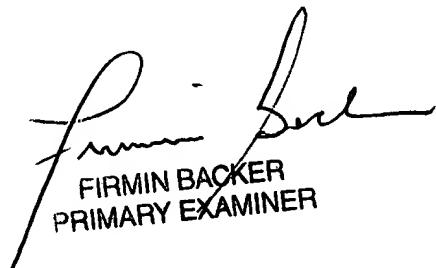
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jalatee Worjloh  
Patent Examiner  
Art Unit 3621

January 24, 2006



FIRMIN BACKER  
PRIMARY EXAMINER